



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,119	01/14/2004	Xiaoming Wu	PRMSP0300US	2966

56320 7590 02/09/2006

NEIL A. DUCHEZ (PROMERUS)  
RENNER, OTTO, BOISSELLE & SKLAR, LLP  
1621 EUCLID AVENUE  
19TH FLOOR  
CLEVELAND, OH 44115

EXAMINER
----------

SCHILLING, RICHARD L

ART UNIT	PAPER NUMBER
----------	--------------

1752

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/757,119

Applicant(s)

WU ET AL.

Examiner

Richard L. Schilling

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-21 and 24-27 is/are rejected.
- 7) ☒ Claim(s) 3,22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-18-05;10-24-05</u> . | 6) <input type="checkbox"/> Other: _____  |

1. Claims 1, 2, 4, 5, 7-20 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The intended scope of the instant claims is indefinite since "norbornene-type" repeating units, as defined in the specification on page 4, do not include the formulas as set forth in the instant claims where X and X' are other than CH<sub>2</sub> while the instant claims require only norbornene-type repeating units.

2. Claims 1,7,13, 15, 17, 20, 21, 26 and 27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tachibana et al. The rationale of the 35 USC 102 rejection is set forth on paragraphs 5 and 6 of the last office action filed 7-08-05 incorporated therein by reference. Applicants' argument that the instant claims are limited to polymers with norbornene units is unconvincing. Claim 26 is not directed to polymers but monomers disclosed by Tachibana et al. Tachibana et al. ( col. 1, line 49-col. 2, line 55; col. 6, lines 1-36; claims 1 and 2 ) disclose polymers with units of formula 1-1( norbornene type ) and optionally formula 1-2 ( norbornene type ). Monomers of formulas 3 and 4, which are not norbornene type, are disclosed as optional. The disclosure in Tachibana et al. is not limited to the specific examples. If Tachibana et al. do not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use the disclosed polymers of Tachibana et al. without the optional monomers of formulas 3 or 4.

3. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Tachibana et al. for the same reasons as set forth in paragraphs 8 and 9 of the last office action.

4. Claims 1, 4, 7-10, 21 and 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Ravikiran et al. for the same reasons as set forth in paragraph 10 of the last office action. The declaration stating that Ravikiran et al. derived their disclosure of the subject matter of the instant claims from the instant inventors is unconvincing since Ravikiran et al. (claims 5 and 6; examples 1,2; paragraph 126) claim the subject matter of the instant claims in their claims 5 and 6. Instant claims 4, 5, 9 and 24-27 claim subject matter substantially the same as covered by claims 5 and 6 of Ravikiran et al.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 7-10, 21 and 24-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5 and 6 of copending Application No. 10/ 860876 to Ravikivan et al. ( PG Pub.

2005/0019638 ). Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 5 and 6 of 10/860876 are encompassed by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1, 13-15, 17, 18,20,21,26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinsho et al. '961. Kinsho et al. ( see particularly col. 2, lines 1-26; col. 4, line 34-col. 5, line 43; col. 8, line 51-col. 9, line 9; monomers 1,3 ) disclose polymers and monomers as set forth in the instant claims when t is 0 and m is 1 in the instant claims.

7. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinsho et al. '961. While Kinsho et al. does not specifically disclose 157nm exposure, sensitivity to deep uv is generically disclosed so that exposure to 157nm would be obvious to one skilled in the art.

8. Claims 3, 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The prior art cited by applicants has been considered.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

Art Unit: 1752

MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Richard L. Schilling at telephone number 571-272-1335.

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 1400

A handwritten signature in black ink, appearing to read 'Richard L. Schilling', is written over the printed name and title. The signature is stylized and includes a large, sweeping flourish at the end.